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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/624,875	07/21/2003	Nobuyuki Shomura	9871/0N071US0	6794
7278	7590	06/04/2004	EXAMINER	
DARBY & DARBY P.C. P. O. BOX 5257 NEW YORK, NY 10150-5257			VASUDEVA, AJAY	
			ART UNIT	PAPER NUMBER
			3617	

DATE MAILED: 06/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/624,875

Applicant(s)

SHOMURA, NOBUYUKI

Examiner

Ajay Vasudeva

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 5-10 is/are rejected.
- 7) ☐ Claim(s) 3 and 5 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 8 (line 4), use of "a displacement detection sensor such as a variable resistor" (emphasis added) makes the claim indefinite because it uses a broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim), thus failing to define clearly set forth metes and bounds of the patent protection desired.

Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949).

In the present instance, the claim recites the broad recitation "a displacement detection sensor", and the claim also recites "such as a variable resistor", which is the narrower statement of the range/limitation.

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claim 1, 2, 9 and 10 are rejected under 35 U.S.C. 102(e) as being anticipated by Shidara et al. ('882).

Shidara et al. shows an outboard motor (figure 1) having a throttle operating unit [26] for operating an opening of a throttle valve [50] to control a volume of intake air to the engine, an electric air control valve (EACV) [74] for increasing and decreasing the volume of intake air to the engine via a separate system from the throttle valve, a control unit [22] including an actuator for controlling the opening and closing of the air control valve. An engine speed operating unit [34] adjacent a shift lever [32] is provided to directly input an air increase or decrease signal into the control unit when the shift lever is moved between neutral or forward/reverse mode, respectively (see col. 4, lines 5-12; and also figure 4).

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3. Claim 1, 5, 9 and 10 are rejected under 35 U.S.C. 102(e) as being anticipated by Kanno ('852).

Kanno ('852) shows an outboard motor (figures 1 and 4) having a throttle operating unit [188, 190] for operating an opening of a throttle valve [184] to control a volume of intake air to the engine, an electric air control valve [224] for increasing and decreasing the volume of intake air to the engine via a separate system from the throttle valve, a control unit [110] including an actuator for controlling the opening and closing of the air control valve. An engine speed operating unit [170], based on the information indicating the opening state of the throttle valve and the engine speed, provides a basis for directly inputting at least an air decrease signal into the control unit when the shift lever is shifted. (see also figure 5).

4. Claim 1, and 5-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Kanno et al. ('766).

Kanno et al. ('766) shows an outboard motor (figures 1 and 4) having a throttle operating unit [178, 180] for operating an opening of a throttle valve [174] to control a volume of intake air to the engine, an air control valve [212] for increasing and decreasing the volume of intake air to the engine via a separate system from the throttle valve, a control unit [110] including an actuator (col. 7, lines 32-35) for controlling the opening and closing of the air control valve. An engine speed operating unit [280] provides a basis for directly inputting an air increase or decrease signal into the control unit according to user's preference (see figure 1 and col. 9, 10 and 11). The control unit restores the air control valve to a predetermined fundamental control value when the throttle valve is controlled by the throttle operating unit. The engine speed operating unit is adapted to output an air increase or decrease signal utilizing a variable resistor (col. 11, lines 9-10).

***Allowable Subject Matter***

5. Claims 3 and 4 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Miyashita et al., Suzuki et al., Mashiko, Nakayasu, Katayama, Iwata, Ono et al., Tanaka, Fukui, Soden and Kanno (147, 283, 032, 298 and 525) show idle speed control systems.

**Examiner's Observations:** The applicant has claimed a speed operating unit to directly input an air increase or decrease signal into a control unit. However, it is noted that the applicant has not characterized such speed operating unit as employing a manual input according to user's preference. Absent such a "manual input by the user" limitation, a majority of the above cited references are also considered as anticipating at least claim 1 because they employ sensor units to directly input a signal to a control unit, which form a basis for an air increase or decrease decision by the control unit. Therefore, such sensor units are considered as equivalent to the speed operating unit that directly input an air increase or decrease signal into a control unit.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ajay Vasudeva whose telephone number is (703) 306-5992. The examiner can normally be reached on Monday-Friday 1:00 pm--5:30 pm.


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, S. Joe Morano can be reached on (703) 308-0230. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ajay Vasudeva  
Examiner  
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AV

  
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